REMARKS

The Office Action dated January 2, 2004, was a final rejection of claims 1-34 of the above-referenced patent application. However, the Applicants believe that the application is in condition for allowance because the claims are patentable over the cited art. Thus, the Applicants respectfully request further examination and reconsideration of the subject application. The reasons for this belief in the patentability of the rejected claims are presented below.

With regard to independent claim 1 and 2, it is generally the Applicants' belief that Maggioncalda et al. ('217) is not prior art. Without the availability of Maggioncalda et al. ('217) as prior art, the Geller et al. reference does not make obvious the Applicants' claimed invention (as admitted by the Office Action).

With regard to independent claim 13, in general the Applicants believe that the cited combination of Geller et al. and Contois does not disclose, suggest or provide any motivation for, either explicitly or implicitly, the material claimed feature of using the rules to prevent a user from encountering a conflict by <u>automatically correcting any conflicts</u> to prevent the conflicts from being displayed. This is because in the combination of Geller et al. and Contois there is no opportunity for conflicts in the data. Thus, there is no automatic correction of conflicts because no conflicts can exist among the type of data described and suggested by the combination. There is no need for automatic correction of conflicts, since there can be no conflicts.

With regard to independent claim 18, in general the Applicants submit that the cited combination of Geller et al. and Contois does not disclose, suggest or provide any motivation for, either explicitly or implicitly, the material claimed feature of receiving a request for information based on <u>user-defined criteria</u> from a remote computer such that transmitted results are <u>narrowed, limited and targeted</u> to the information. The combination merely discusses downloading to update or install a configuration program in its entirety. The request is <u>not</u> designed to narrow and limit the results obtained by the remote computer. Unlike the Applicants' claimed invention, narrowing and limiting the results

obtained from the request based on user-defined criteria is neither explicitly nor implicitly disclosed by the combination.

Regarding independent claim 32, in general the Applicants believe the following: (1) as with claims 1 and 2, Maggioncalda et al. ('217) is not prior art; (2) as with claim 18, the cited combination does not disclose, suggest or provide any motivation for, either explicitly or implicitly, the material claimed feature of transmitting a request for information based on user-defined criteria from the client computer such that transmitted results are narrowed, limited and targeted to the information; and (3) the cited combination does not disclose, suggest or provide any motivation for, either explicitly or implicitly, the material claimed feature of <u>automatically selecting</u> at least one <u>additional sub-item</u> in response to a user selecting a sub-item during the user adjustment of the transmitted data that requires selection of the at least one addition sub-item and dynamically displaying the processed data values on a client display device of the client computer.

The specific rejections will now be discussed in greater detail.

Section 103(a) Rejections

The final Office Action rejected claims 1-12 and 19-30 under 35 U.S.C. § 103(a) as being unpatentable over Geller et al. (U.S. Patent No. 5,844,554) in view of Maggioncalda et al. (U.S. Patent No. 5,918,217). The Office Action contended that Geller et al. disclose all elements of the Applicants' claimed invention except that Geller et al. do "not teach the step of transmitting the request for information based on user-defined criteria from the client computer such that transmitted results are narrowed, limited and targeted to the information". However, the Office Notice stated that "[T]his is what Maggioncalda teaches (col. 18, lines 3-52)."

The Applicants respectfully disagree with these statements. It is the Applicants' position that the reference of Maggioncalda et al. is not prior art in relation to Applicants' invention.

In general, as set forth in 37 CFR § 1.131, if a reference does not claim the same patentable invention as the Applicants, and the Applicants reduced the invention to practice in the United States prior to the effective date of the reference, then the reference is not prior art in relation to the Applicants' invention. The Applicants respectfully maintain that these circumstances exist in the subject case.

First, Maggioncalda et al. (U.S. Patent No. 5,918,217 -- hereinafter "Maggioncalda et al. ('217)") do not claim the same patentable invention as the Applicants' claimed invention. In accordance with 37 C.F.R. § 1.601(n), the "same patentable invention" is one where an applicant's invention is anticipated under 35 U.S.C. § 102 or obvious under 35 U.S.C. § 103. The Applicants' claimed invention is not anticipated by Maggioncalda et al. ('217) because Maggioncalda et al. ('217) lack at least one claimed element of the Applicants' invention. In particular, Maggioncalda et al. ('217) lack the Applicants' claimed element of preventing a user from creating and encountering sub-item conflicts using transmitted rules of enforcement (for claim 1) and rules of enforcement that contain all predefined known conflicts between the associated criteria in different data fields (for claim 2). Consequently, Maggioncalda et al. ('217) do not anticipate the Applicants' claimed invention.

The Applicants' claimed invention also is not obvious under 35 U.S.C. § 103 in view of Maggioncalda et al. ('217). A prima facie showing of obviousness must consider all of the claimed elements of an applicant's invention, especially when these claimed elements are missing from the prior art. If a claimed element is not taught in the prior art and has advantages not appreciated by the prior art, then no prima facie showing of obviousness has been made. The Federal Circuit Court has held that it was an error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Moreover, if the prior art references do not disclose, suggest or provide any motivation for at least one claimed element of an applicant's invention then a prima facie case of obviousness has not been established (MPEP § 2142).

Independent claims 1 and 2 of the Applicants' invention include rules of enforcement that are used to prevent sub-item conflicts. In contrast, as noted in a prior Office Action dated October 25, 2001 (Paper No. 17), Maggioncalda et al. ('217) do not disclose, suggest or provide motivation for this claimed element. Moreover, Maggioncalda et al. ('217) fail to appreciate the advantages of the rules of enforcement. Specifically, the rules of enforcement prevent any conflicts involving sub-items, thereby preventing a user from selecting invalid combinations when interactively manipulating data.

Accordingly, the Applicants respectfully contend that independent claims 1 and 2 are nonobvious over Maggioncalda et al. ('217). Further, claims 6-12 and 19-26 depend from independent claim 1 and claims 3-5 and 27-30 depend from independent claim 2 and are also nonobvious over Maggioncalda et al. ('217) (MPEP § 2143.03).

Thus, the Applicants' invention is not the "same patentable invention" as Maggioncalda et al. ('217) under 37 C.F.R. § 1.601(n) because the Applicants' invention is neither anticipated by Maggioncalda et al. ('217) under 35 U.S.C. § 102 nor obvious in view of Maggioncalda et al. ('217) under 35 U.S.C. § 103. Accordingly, Maggioncalda et al. ('217) do not claim the same patentable invention as the Applicants' claimed invention.

Second, in order to prove that Maggioncalda et al. ('217) is not prior art in relation to the Applicants' invention, it also must be shown that the Applicants reduced their invention to practice in the United States prior to the effective date of Maggioncalda et al. ('217). The effective date of Maggioncalda et al. ('217) is the filing date of December 10, 1997.

The Applicants' reduction to practice is before the effective date of December 10, 1997 of Maggioncalda et al. ('217). The Applicants reduced the invention to practice at Microsoft Corporation in Redmond, Washington prior to the effective date of December

10, 1997. This is evidenced in the record by a declaration of one of the Applicants and an associated exhibit. The declaration states the reduction to practice occurred prior to December 10, 1997, and the exhibit supports this statement. The exhibit is an e-mail, dated October 3, 1997, from a leader on the CarPoint development team to other members of the team indicating that the beta version of Carpoint version 2.0 is ready for beta testing. Moreover, the declaration signed by one of the inventors states that the beta version of Carpoint version 2.0 referred to in the e-mail includes the Applicants' claimed invention. The e-mail along with the declaration proves reduction to practice, and the date of the e-mail proves that reduction to practice occurred at least before December 10, 1997. The date of the e-mail is at least over two months before the effective date of Maggioncalda et al. ('217). Accordingly, the Applicants respectfully submit that they have shown that the required reduction to practice in the United States prior to any effective dates of Maggioncalda et al. ('217).

The above-mentioned declaration and exhibit were filed on January 25, 2002, and are of record. The declaration and exhibit were filed to swear behind a child of the Maggioncalda et al. ('217), namely Maggioncalda et al. (U.S. Patent No. 6,012,444; hereinafter Maggioncalda et al. ('444). However, the Applicants' assert that the declaration and exhibit used to swear behind of Maggioncalda et al. ('444) are valid to swear behind Maggioncalda et al. ('217) since the declaration and exhibit that are of record clearly establish that a date of conception prior to December 10, 1997. In addition, the passage in the parent Maggioncalda et al. ('217) that the Examiner relies on to establish the missing step of "transmitting the request for information based on user-defined criteria from the client computer such that transmitted results are narrowed, limited and targeted to the information" (namely, col. 18, lines 3-52) is contained verbatim in the child Maggioncalda et al. ('444) (namely col. 18, lines 38-67 to col. 19, lines 1-19). Thus, in this case, swearing behind the child (Maggioncalda et al. ('444)) previously is enough to also swear behind the parent Maggioncalda et al. ('217).

The Applicants have shown that Maggioncalda et al. ('217) do not claim the same patentable invention as the Applicants' invention and that the Applicants reduced

the invention to practice in the United States prior to any effective date of Maggioncalda et al. ('217). Consequently, the Applicants respectfully submit that Maggioncalda et al. ('217) is not prior art in relation to the Applicants' invention. Accordingly, the Applicants' invention is patentable in view of Maggioncalda et al. ('217) under 35 U.S.C. § 103(a).

In view of this unavailability of Maggioncalda et al. ('217) as prior art, the Applicants respectfully submit that the rejection of claims 1-12 and 19-30 under 35 U.S.C. § 103(a) as being unpatentable over Geller et al. in view of Maggioncalda et al. ('217) has been overcome. The Applicants, therefore, respectfully request reexamination, reconsideration and withdrawal of the rejection of claims 1-12 and 19-30 under 35 U.S.C. § 103(a).

The final Office Action rejected claims 13-18 and 31 under 35 U.S.C. § 103(a) as being unpatentable over Geller et al. (U.S. Patent No. 5,844,554) in view of Contois (U.S. Patent No. 5,864,868). The Office Action contended that Geller et al. disclose all elements of the Applicants' claimed invention except that Geller et al. do "not disclose the step of automatically correcting any conflicts to prevent the conflicts from being displayed and viewed by the user during the user interaction." However, the Office Notice stated that "such a feature is well known in the art. For instance, Contois teaches a user interface for allowing a user access to information stored in a database, wherein conflicting and unrelated information are automatically and adaptively being prevented from displaying and viewing (col. 10, lines 28-36)."

The Applicants respectfully disagree with this contention. In general, the Applicants submit that the combination of Geller et al. and Contois lacks at least one element of the Applicants' claimed invention. In particular, the combination does not suggest or provide any motivation for, either explicitly or implicitly, the material claimed feature of using the rules to prevent a user from encountering a conflict by automatically correcting any conflicts to prevent the conflicts from being displayed. Further, the combination fails to appreciate the advantages of this claimed feature. Thus, the

Applicant submits that the combination of Geller et al. and Contois cannot make obvious the Applicants' claimed invention.

To make a prima facie showing of obviousness, all of the claimed features of an Applicant's invention must be considered, especially when they are missing from the prior art. If a claimed feature is not disclosed in the prior art and has advantages not appreciated by the prior art, then no prima facie showing of obviousness has been made. The Federal Circuit Court has held that it was an error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein. *In re Fine,* 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Moreover, as stated in the MPEP, if a prior art reference does not <u>disclose, suggest or provide any motivation</u> for at least one claimed feature of an Applicant's invention, then a prima facie case of obviousness has not been established (MPEP § 2142).

Independent Claim 13

Independent claim 13 of the Applicants' claimed invention includes a method for dynamically displaying pricing data on a client display device. The method includes establishing a communications interface between a client computer and a server computer, requesting pricing data from the client to the server for at least one object, and generating pricing data with associated options and rules for selection and combination of the associated options for each object at the server. The method further includes transmitting the pricing data, associated options, and rules for selection and combination of the associated options from the server to the client, displaying a first set of pricing results on the client display device, and providing a user interface on the client display device for user interaction with the pricing data and selection and combination of the associated options. The method also includes using the rules to prevent a user from encountering a conflict by <u>automatically correcting</u> any <u>conflicts</u> to <u>prevent</u> the <u>conflicts</u> from being <u>displayed</u> during the user interaction with the pricing data, the rules for selection and combination containing all potential conflicts that may occur during the user interaction and corresponding safeguards to prevent the user from encountering

and viewing a conflict during the user interaction with the pricing data. The method also includes dynamically updating the pricing data using the client computer to process the update and displaying the pricing data on the client display device in response to user interaction with the pricing data and associated options, and rules for selection and combination.

In the Applicants' claimed invention, rules for selection and combination of the associated options for each object are used to prevent a user from encountering a conflict by automatically correcting any conflicts to prevent conflicts from being displayed. Automatic correction of any conflicts means that other options are automatically adjusted when a given option is selected by the user. There is no disabling of an option (as in Geller et al.). Automatic correction of conflicts means avoids user confusion typically associated with disable user interface (UI) elements, where the user is not sure why the UI elements are disabled or how to undo the action.

Automatic correction also prevents conflicts. This prevention occurs during the user interaction with the pricing data. In addition, the rules contain all potential conflicts that may occur during the user interaction and corresponding safeguards to prevent the user from not only encountering but also even viewing a conflict. As an example used in the specification, "only sub-items that are applicable to a particular car make, model and year are displayed with the results" (specification, page 21, lines 20-21). Thus, any sub-items that may lead to a conflict are not displayed. In this manner, the user cannot encounter a conflict because the conflicting choices are not available for selection because they are not displayed.

In contrast, Geller et al. displays a selection of choices to a user, including conflicting choices. Moreover, not only is a conflicting choice displayed, but the user is allowed to select a conflicting choice. Only after the choice is displayed and selected is the user notified that the choice is a conflicting choice.

Specifically, referring to FIG. 13 of Geller et al., a combo box 1302 "shows all the

various choices available" (col. 23, lines 62-63). An attempt by a user to enter the number 2 causes (or allows) the numeral 2 to be entered in the box (col. 24, lines 10-11). Note that "2" is a conflicting choice. Only _after_ the choice is made is the constraint applied and the system realizes that the choice is invalid and conflicting (col. 24, lines 10-14). The conflicting choice then is displayed in reverse video 1320 (col. 24, lines 12-14). Similarly, a text entry box 1305 allows display and selection of conflicting or invalid choices. Then, after selection, the conflicting choice is displayed in reverse video 1322 (col. 24, lines 14-16). For the radio button set shown 1307 in FIG. 13, the conflicting choices are "grayed out" 1325 (col. 24, lines 17-28). However, these conflicting choices still are displayed. Moreover, Geller et al. offers no automatic correction of conflicts.

Contois adds nothing to the cited combination that would make obvious the Applicants' claimed invention. All that is happening in Contois is that "[S]election of a single or multiple items in this data field provides the user with control over what items may be displayed in the other data fields" (col. 9, lines 62-67 to col. 10, line 1). There is no opportunity for conflicts in the data of Contois. Thus, there is no automatic correction of conflicts in Contois because no conflicts can exist among the type of data described and suggested by Contois. In other words, the data contained in Contois can exist together, and none of the data is mutually exclusive of each other. There is no need for automatic correction of conflicts, since there can be no conflicts.

The combination also fails to appreciate or recognize the advantages of the Applicant's claimed feature of using the rules to prevent a user from encountering a conflict by automatically correcting any conflicts to prevent the conflicts from being displayed during the user interaction with the pricing data. More specifically, automatic correction of conflicts means avoids user confusion typically associated with disable user interface (UI) elements, where the user is not sure why the UI elements are disabled or how to undo the action. In addition, the rules contain all potential conflicts that may occur during the user interaction and corresponding safeguards to prevent the user from not only encountering but also even viewing a conflict. The combination of Geller et al. and Contois et al. simply does not discuss or appreciate these advantages of the Applicant's

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claimed feature of using the rules to prevent a user from ncountering a conflict by automatically correcting any conflicts to prevent the conflicts from being displayed during the user interaction with the pricing data.

The Applicants, therefore, submit that obviousness cannot be established since the combination of Geller et al. and Contois et al. does not teach, disclose, suggest or provide any motivation for the Applicants' claimed feature of using the rules to prevent a user from encountering a conflict by automatically correcting any conflicts to prevent the conflicts from being displayed during the user interaction with the pricing data. In addition to explicitly lacking these features, the combination of Geller et al. and Contois et al. also fails to implicitly disclose, suggest, or provide motivation for these features. Further, the combination fails to appreciate the advantages of these claimed features.

Therefore, as set forth in *In re Fine* and MPEP § 2142, the combination of Geller et al. and Contois cannot render the Applicants' claimed invention obvious because these references are missing at least two material features of the Applicant's claimed invention. Consequently, because a prima facie case of obviousness cannot be established due to the lack of "some teaching, suggestion, or incentive supporting the combination", the rejection must be withdrawn. <u>ACS Hospital Systems, Inc. v.</u> <u>Montefiore Hospital</u>, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984); MPEP 2143.01.

Accordingly, the Applicants respectfully submit that independent claim 13 is patentable under 35 U.S.C. § 103(a) over Geller et al. in view of Contois based on the legal and technical arguments set forth above and below. Moreover, claims 14-17 and 31 depend from independent claim 13 and are also nonobvious over Geller et al. in view of Contois (MPEP § 2143.03). The Applicants, therefore, respectfully requests reexamination, reconsideration and withdrawal of the rejection of claims 13-17 and 31.

<u>Independent Claim 18</u>

Independent claim 18 of the Applicants' claimed invention includes a method for enforcing valid combinations of data using a server computer. The method includes receiving a request for information based on <u>user-defined criteria</u> from a remote computer such that transmitted results are <u>narrowed, limited and targeted</u> to the information, and transmitting results, sub-items associated with the results, and rules of enforcement of sub-item combinations in a predefined format from the server to the remote computer in response to the request. Processing of the transmitted results is performed in real time in response to a user adjustment of the transmitted results and sub-items associated with the transmitted results. The method further includes preventing a user of the remote computer from creating, encountering, and viewing conflicts between sub-items in different data fields during the user adjustment of the sub-items by using the rules of enforcement such that only the sub-items applicable to the user-defined criteria are displayed on the remote computer. The rules of enforcement containing all potential configurable conflicts and predefined known conflicts between the sub-items.

In the Applicants' claimed invention, a server computer first receives a request for information based on user-defined criteria (specification, page 17, lines 8-9; FIG. 5). This criteria is entered by the user and "narrows the data results" (specification, page 17, lines 9-10). "For example, the user can request pricing information for used cars based on manufacturer, model, year, geographical location, trim, etc. As such, the user defined criteria enables production of limited and targeted results, such as results for a particular car manufacturer, model and year, instead of all the cars made for a particular manufacturer" (specification, page 17, lines 10-15). Thus, the Applicants' claimed feature of transmitting a request for information is based on user-defined criteria and is designed to narrow the results obtained from the request such that those results are narrowed, limited and targeted.

In contrast, Geller et al. merely disclose transmitting a request for an entire configuration program (or updates) based on the need to update or install the program on a remote computer. In particular, a "copy of the executable configuration program" is

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downloaded from the server by a "remote synchronization agent or client program" (Geller et al., col. 8, lines 39-50). It should be noted, however, that the request is not based on criteria defined by a user.

Geller et al. merely discuss distributing layout information, category lists and controls via the compiled module. Moreover, Geller et al. only download separately specific subsets of data that frequently change. Moreover, the request is not designed to narrow and limit the results obtained by the remote computer. In fact, the purpose of the download in Geller et al. is to update or install the configuration program in its entirety. Unlike the Applicants' claimed invention, narrowing and limiting the results obtained from the request based on user-defined criteria is neither explicitly nor implicitly disclosed by Geller et al..

Contois adds nothing to the cited combination that would make obvious the Applicants' claimed invention. In fact, Contois does not even mention or suggest in any manner the Applicants' claimed feature of receiving a request for information based on user-defined criteria from a remote computer such that transmitted results are narrowed, limited and targeted to the information.

The combination of Geller et al. and Contois also fails to appreciate or recognize the advantages of the Applicant's claimed feature receiving a request for information based on user-defined criteria from a remote computer such that transmitted results are narrowed, limited and targeted to the information. More specifically, downloading only results that are narrowed, limited and targeted to the request for specific information eliminates the need for maintenance and distribution of a compiled executable, even for significant changes such as new categories, options or processing logic. The combination of Geller et al. and Contois et al. simply does not discuss or appreciate these advantages of the Applicant's claimed feature receiving a request for information based on user-defined criteria from a remote computer such that transmitted results are narrowed, limited and targeted to the information.

The Applicants, therefore, submit that obviousness cannot be established since the combination of Geller et al. and Contois et al. does not teach, disclose, suggest or provide any motivation for the Applicants' claimed feature of receiving a request for information based on user-defined criteria from a remote computer such that transmitted results are narrowed, limited and targeted to the information. In addition to explicitly lacking these features, the combination of Geller et al. and Contois et al. also fails to implicitly disclose, suggest, or provide motivation for this feature. Further, the combination fails to appreciate the advantages of this claimed feature.

Therefore, as set forth in *In re Fine* and MPEP § 2142, the combination of Geller et al. and Contois et al. cannot render the Applicants' claimed invention obvious because these references are missing at least two material features of the Applicant's claimed invention. Consequently, because a prima facie case of obviousness cannot be established due to the lack of "some teaching, suggestion, or incentive supporting the combination", the rejection must be withdrawn. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984); MPEP 2143.01.

Accordingly, the Applicants respectfully submit that independent claim 18 is patentable under 35 U.S.C. § 103(a) over Geller et al. in view of Contois based on the legal and technical arguments set forth above and below. The Applicants, therefore, respectfully requests reexamination, reconsideration and withdrawal of the rejection of claim 18.

The final Office Action rejected claims 32-34 under 35 U.S.C. § 103(a) as being unpatentable over Geller et al. (U.S. Patent No. 5,844,554) in view of Maggioncalda et al. (U.S. Patent No. 5,918,217) and Contois (U.S. Patent No. 5,864,868). The Office Action contended that the combination of Geller et al., Maggioncalda et al. and Contois disclose all elements of the Applicants' claimed invention.

The Applicants respectfully disagree with this contention. In general, as explained above, it is the Applicants' position that the reference of Maggioncalda et al. ('217) is not prior art in relation to Applicants' invention. Moreover, the Applicants submit that remaining combination of Geller et al. and Contois lacks at least one feature of the Applicants' claimed invention.

Independent claim 32 of the Applicants' claimed invention includes a method for dynamically displaying data values on a client computer. The method includes transmitting a request for information based on user-defined criteria from the client computer such that transmitted results are narrowed, limited and targeted to the information and receiving transmitted data values, sub-items associated with the data values, and rules of enforcement of sub-item combinations in a predefined format through a communications interface in response to a request from the client computer. The rules of enforcement contain all known conflicting sub-item combinations. The method further includes creating a control module on the client computer, using the control module to control the transmitted data values and process in real time user adjustment of the transmitted data values and sub-item combinations, and automatically noting the known conflicting sub-item combinations between a sub-item in a first field and another sub-items in second field using the rules of enforcement. The method also includes preventing a user from creating, encountering, and viewing conflicts between sub-item combinations during the real-time user adjustment using the noted known conflicting sub-item combinations such that only the sub-items applicable to the user-defined criteria are displayed on the remote computer. Moreover, the method includes automatically selecting at least one additional sub-item in response to a user selecting a sub-item during the user adjustment of the transmitted data that requires selection of the at least one addition sub-item and dynamically displaying the processed data values on a client display device of the client computer.

In contrast, as note above with regard to amended independent claim 18, the combination of Geller et al. and Contois do not disclose, suggest, or provide motivation for the Applicants' claimed f ature of transmitting a request for information based on

user-defined criteria from the client computer such that transmitted results are narrowed, limited and targeted to the information. Moreover, the combination of Geller et al. and Contois does not appreciate the advantages of this claimed feature of Applicants' invention.

In addition, the combination of Geller et al and Contois fails to disclose the Applicants' claimed feature of automatically selecting at least one additional sub-item in response to a user selecting a sub-item during the user adjustment of the transmitted data that requires selection of the at least one addition sub-item. Referring to FIGS. 9 and 10 in the Applicants' specification, "if a particular sub-item 970, 1070 requires another sub-item 980, 1080 as a prerequisite, the prerequisite sub-item 980, 1080 will automatically be selected when the client user selects the particular sub-item 970, 1070" (specification, page 22, lines 3-6). Although Geller et al. discuss deselecting mutually exclusive items, nowhere do Geller et al. disclose the Applicants' claimed feature of automatically selecting a prerequisite sub-item when a particular sub-item is chosen. Contois does not even discuss or suggest this claimed feature of Applicants' invention.

The combination of Geller et al. and Contois also fails to appreciate or recognize the advantages of the Applicants' claimed features, as discussed above. The Applicants, therefore, submit that obviousness cannot be established since the combination of Geller et al. and Contois et al. does not teach, disclose, suggest or provide any motivation for the Applicants' claimed features of: (1) transmitting a request for information based on user-defined criteria from the client computer such that transmitted results are narrowed, limited and targeted to the information; and (2) automatically selecting at least one additional sub-item in response to a user selecting a sub-item during the user adjustment of the transmitted data that requires selection of the at least one addition sub-item. Further, the combination fails to appreciate the advantages of these claimed features.

Therefore, as set forth in *In re Fine* and MPEP § 2142, the combination of Geller et al. and Contois cannot render the Applicants' claimed invention obvious because these references are missing at least two material features of the Applicant's claimed

invention. Consequently, because a prima facie case of obviousness cannot be established due to the lack of "some teaching, suggestion, or incentive supporting the combination", the rejection must be withdrawn. <u>ACS Hospital Systems, Inc. v. Montefiore Hospital</u>, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984); MPEP 2143.01.
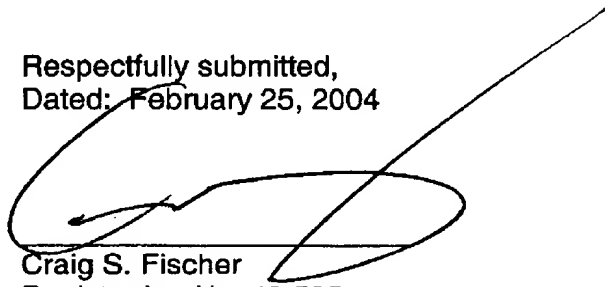
Accordingly, the Applicants respectfully submit that independent claim 32 is patentable under 35 U.S.C. § 103(a) over Geller et al. in view of Maggioncalda et al. and Contois. Moreover, claims 33 and 34 depend from independent claim 32 and are also nonobvious over Geller et al. in view of Maggioncalda et al. and Contois (MPEP § 2143.03). The Applicants, therefore, respectfully requests reexamination, reconsideration and withdrawal of the rejection of claims 32-34.

<u>Conclusion</u>

In view of the arguments set forth above, the Applicants submit that claims 1-34 of the subject application are in immediate condition for allowance. The Examiner, therefore, is respectfully requested to withdraw the outstanding rejections of the claims and to pass all of the claims of this application to issue.

In an effort to expedite and further the prosecution of the subject application, the Applicants kindly invite the Examiner to telephone the Applicants' attorney at (805) 278-8855 if the Examiner has any comments, questions or concerns, wishes to discuss any aspect of the prosecution of this application, or desires any degree of clarification of this response.

Respectfully submitted,
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